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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD CAUDILL,
ROBERT BECK, GARY NEWMAN,
and HONORIO LIM

Appeal 2007-1112
Application 10/692,116
Technology Center 3700

Decided: 26 March 2008

Before FRED E. McKELVEY, *Senior Administrative Patent Judge*, and
SALLY GARDNER LANE, and MICHAEL P. TIERNEY, *Administrative
Patent Judges*.

LANE, *Administrative Patent Judge*.

DECISION ON REHEARING

I. Statement of the case

In a Decision on Appeal entered 19 July 2007 (“Decision”), the
Examiner’s rejection of claims 1-16 under 35 U.S.C. § 103(a) was affirmed.

Appellants have filed (1) a request for rehearing under 37 C.F.R.
§ 41.52(a)(1)-(3) and (2) a request that our affirmance of the Examiner’s
rejection be designated as a new ground of rejection. According to

Appellants, they are entitled to have prosecution reopened under 37 C.F.R.

§ 41.50(b)(1).¹

The Appellants state as their basis for the request that:

In the Decision on Appeal, dated July 19, 2007, the Board relied upon *KSR International Co. v. Teleflex Inc.*, 500 U.S. ___, [127 S. Ct. 1727] ... (2007), which is an opinion that had not issued as of the time the Appellants filed their Brief and Reply. Further, without specifically identifying a new ground of rejection, the Board has indicated that its decision was, at least partially, based on Appellants' failure to present evidence that any unpredictable results were obtained by Appellants' invention. This point was not raised by the Examiner nor addressed in the appellate filings.

(Request at 1).

To the extent that the request for rehearing is a proper request, we have considered Appellant's arguments based on *KSR*. The request for rehearing is otherwise denied.

We have jurisdiction under 35 U.S.C. § 6(b).

I. Issues

1. Whether, and to what extent, Appellants have shown good cause why new arguments pertaining to *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1272 (2007), cited in the Decision on Appeal entered 19 July 2007, should be considered under 37 C.F.R. § 41.52(a)(2)?

¹ Appellants characterizes its requests as “petitions” but we do not understand Appellants to intend a 37 C.F.R. § 41.3 petition. Appellants do not discuss petitionable subject matter nor cite to Bd. R. 41.3.

2. Whether Appellants have shown that our affirmance of the Examiner's § 103 rejection should be designated as a new ground of rejection? If it is, then Appellants would be entitled to further prosecution before the Examiner. 37 C.F.R. § 41.50(b)(1) and to have new evidence and arguments considered under 37 C.F.R. § 41.52(a)(3).

III. Legal principles

A. Request for rehearing

A request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except that, upon a showing of good cause.

Appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court. 37 C.F.R. § 41.52(a) (1)-(2). New arguments responding to a new ground of rejection made pursuant to § 41.50(b) also are permitted. 37 C.F.R. § 41.52(a) (3).

When the Board makes a new ground of rejection, an appellant may ask for prosecution to be reopened before the Examiner. 37 C.F.R. § 41.50(b) (1).

IV. Analysis

A. Request for rehearing

A review of Appellants' request for rehearing reveals that in many respects it does not comply with 37 C.F.R. § 41.52(a)(1). A request for rehearing must identify the point or points believed to have been misapprehended or overlooked. A request for rehearing is not an opportunity to reargue the appeal.

Appellants' request for rehearing sets forth (1) the real party in interest (page 4), (2) related appeals and interference (page 4), (3) status of the claim (page 4), (4) status of amendments (pages 4), (5) summary of the claimed subject matter (pages 5-6), (5) the claims on appeal (page 6-9), and (6) grounds of rejection to be reviewed on appeal (page 9-18).

We understand Appellants to raise two points in the request for rehearing. Most of the content of the request is not proper, because it attempts to reargue the appeal.

The two points worth of consideration are (1) Appellants' comments relating to KSR and (2) Appellants' request to have the affirmance of the Examiner's rejection designated as a new ground of rejection.

Arguments not raised in the briefs before the Board are not permitted in the request for rehearing except that, *upon a showing of good cause*, Appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court. 37 C.F.R. § 41.52(a)(2) (emphasis added).

Appellants correctly state that *KSR* had not been decided when its appeal brief and reply were filed. It follows that Appellants could not have addressed *KSR* in those briefs. On the other hand, when the time came for us to issue our opinion in support of our affirmance, *KSR* had been decided. Its relevance to the § 103 issue before us is manifest.

Should Appellants be allowed to address our reliance on *KSR*? Clearly, the answer is "yes." We agree with Appellants' statement in the second full paragraph of the request for rehearing that they should be permitted to address *KSR*. However, addressing the applicability of *KSR* does not give Appellants license to re-present their case on appeal. We have considered the arguments in the request for rehearing only to the extent that they present Appellants' views on the applicability of *KSR*. We have otherwise declined to consider the argument in the request for rehearing.

KSR notes that Supreme Court precedent on obviousness has not changed from that set forth previously by the Supreme Court in *Graham v.*

John Deere Co. of Kansas City, 383. U.S. 1 (1966). Accordingly, from a Supreme Court precedent point of view, *KSR* does not amount to any change in obviousness law. It continues to be appropriate in determining whether claimed subject matter would have been obvious to consider, *if in issue*, (1) the scope and content of the prior art, (2) any differences between the claimed invention and the prior art, (3) the level of skill in the art, and (4) any relevant objective evidence of obviousness or non-obviousness. *KSR* at 7, 1730; *Graham* at 17-18.

After citing *KSR*, Appellant attack the Examiner's position without pointing out how we overlooked or misapprehended any *KSR* principle in reaching our decision. Appellants' effort amounts to a re-presentation of the appeal rather than pointing out what was overlooked or misapprehended.

We have considered Appellants' *KSR* arguments to determine if we overlooked or misapprehended any point made in our opinion. Appellants have not convinced us that we did. Accordingly, while we have considered the *KSR* arguments to the extent indicated, we otherwise deny the petition for rehearing.

B. Request for designation of a new ground of rejection

As a second point, Appellants request that we designate our affirmation of the Examiner's § 103 rejection as a new ground of rejection.

According to Appellants, the Examiner did not raise any lack of "unpredictable results" prior to appeal. Further according to Appellants we did. Appellants therefore, in effect, reason that we have changed the thrust of the Examiner's rejection.

With their Request, Appellants filed an affidavit of Ed Schindler (Exh. A) supposedly to meet our statement that "we take into consideration ... (4) any relevant objection (sic—objective) evidence of non-obviousness." Opinion, page 7. Citing *KSR*, we also noted that combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results. Opinion, page 8. Lastly, we noted that Appellants have done nothing more than combine familiar elements according to known methods without demonstrating that any unpredictable results were obtained. Opinion, pages 9-10.

During prosecution, Appellants could have elected to, but apparently did not, present evidence to demonstrate an unpredictable or unexpected result. Evidence of unexpected results, if presented, is relevant. Compare the unexpected results which lead to patentability in (1) *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923) and (2) *Webster Loom Co. v. Higgins*, 105 U.S. 580 (1881). However, despite the fact that the burden of proving unexpected results is on the applicant, in this case

Appellants did not present, and did not rely on, unexpected results before the Examiner or in the appeal and reply briefs. Our statement amounted to an acknowledgment that Appellants did not make "unexpected results" an issue in the appeal. As our opinion notes, Appellants did not direct "us to any evidence establishing that an unpredictable result was achieved." Opinion, page 12. Factual statements in our opinion that Appellants have not presented evidence of unexpected results does not amount to a new ground of rejection—the statements amount to a statement of the state of the record.

In reaching our decision, we did not rely upon any new reference, any new statutory basis, or any new rationale in affirming the Examiner's rejection of all the claims. A statement recognizing that Appellants did not direct us to evidence of unpredictable results does not, as noted above, amount to a new ground of rejection. Rather the statement serves to make clear that such evidence was not before us when we reached our decision.

Accordingly, we decline to designate the Decision on Appeal as containing a new ground of rejection. Therefore, we do not consider the new evidence or the arguments based on that new evidence. Appellants are free to refile the application or take other appropriate steps to continue prosecution where the affidavit can be considered on its merits.

VI. Order

Upon consideration of the record and for reasons given, it is

ORDERED that the request for rehearing is GRANTED-IN-PART (to the extent indicated above), but is otherwise DENIED, and

FURTHER ORDERED that the Decision on Appeal shall not be designated as a new ground of rejection.

GRANTED-IN-PART and DENIED-IN-PART

sd

cc (Via First Class Mail):

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